

**REMARKS/ARGUMENTS**

Upon entry of the above amendment, claims 13, 16, 20, 23, 27, 30, 32, and 35 will have been amended and resubmitted for reconsideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding objections and rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided. Applicant further notes with appreciation the Examiner's withdrawal of the obviousness-type double patenting rejection, in response to Applicant's comments.

Turning to the merits of the action, the Examiner has objected to claims 30-31 and 35-36 because of informalities. By the present amendment, Applicant has amended claims 30-31 and 35-36 to change the term "character sting" to the term --- character string---, in accordance with the Examiner's suggestion. Thus, Applicant respectfully requests that the Examiner withdraw the objection and requests an indication of the allowability of the claims 30-31 and 35-36.

The Examiner has rejected claims 27-29, 30-31, 32-34, and 35-36 under 35 U.S.C. § 112, second paragraph, asserting that these claims recite the limitation "the image receiving apparatus comprising", for which there is insufficient antecedent basis in each of the claims. By the present amendment, Applicant has amended the claims to ensure sufficient antecedent basis for the limitation therein, in accordance with the Examiner's suggestion. Thus, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner has rejected claims 13-15 and 20-22 under 35 U.S.C § 103(a) as being unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of RFC 2305 (RFC2305\_ "A Simple Mode of Facsimile Using Internet MAIL" March 1998). The Examiner also has rejected claims 16-19, 23-26, 27, 30, and 32 under 35 U.S.C § 103(a) as being unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of PRAITIS et al. (U.S. Patent No. 6,594,697) and MORI (U.S. Patent No. 6,417,930). The Examiner further has rejected claims 28-29 and 33-34 under 35 U.S.C § 103(a) as being unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of PRAITIS et al. (U.S. Patent No. 6,594,697), MORI (U.S. Patent No. 6,417,930), and IWAZAKI (U.S. Patent No. 6,687,742).

As noted above, Applicant has amended claims 13, 16, 20, 23, 27, 30, 32, and 35 merely to clarify the recitations thereof and not in view of the cited prior art, and thus claims 13-36 remain pending for consideration.

Applicant respectfully traverses the above rejections based on these pending claims 13-36, and will discuss the rejections with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 13-15 relate to an image communication apparatus which has a transmitter configured to transmit an e-mail with data attached, via a computer network and has a receiver configured to receive an e-mail with data attached, via the computer network. The image communication apparatus comprises a controller configured to convert the attached data into image data. The controller judges whether

or not the received e-mail is an error mail, based on whether or not a header of the received e-mail includes a predetermined character string. The predetermined character string is related to a sender of the error mail. The error mail is related to the e-mail transmitted by the image communication apparatus. Claims 20-22 recite related methods.

Applicant's claims 16-19 relates to an image communication apparatus which transmits and receives an e-mail. The e-mail includes a header and a body which has a message. The message includes an image data part. The image communication apparatus has a transmitter configured to transmit an e-mail with data attached, via a computer network and has a receiver configured to receive an e-mail with data attached, via the computer network. The image communication apparatus also has a controller configured to convert the attached data to image data. The controller further searches for a predetermined image data fixed code in the image data part of the body of the e-mail when the received e-mail is a multi-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is detected. The error mail is related to an e-mail transmitted by the image communication apparatus. Claims 23-26 recite related methods.

Applicant's claims 27-29 relate to an image communication apparatus connected to a server and configured to receive an e-mail. The e-mail includes a header and a body which has a message. The message includes an image data part. The image communication apparatus has a transmitter configured to transmit an e-mail with data attached, via the server and has a receiver configured to receive an e-mail to which data is attached, via the server. The image communication apparatus has a converter

configured to convert the attached data into image data. The image communication apparatus also has a memory configured to store a predetermined image data fixed code. Further, the image communication apparatus has a controller which searches for a predetermined header fixed message in the header of the received e-mail, searches for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not found in the header of the received e-mail, and judges that the received e-mail is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory. The error mail is related to an e-mail transmitted by the image communication apparatus. Claims 32-34 recite related methods.

Applicant's claims 30-31 relate to an image communication apparatus connected to a server and configured to receive an e-mail. The e-mail includes a header and a body which has a message. The message includes an image data part. The image communication apparatus has a transmitter configured to transmit an e-mail with data attached, via the server and has a receiver configured to receive an e-mail with data attached, via the server. The image communication apparatus has a converter configured to convert the attached data into image data. The image communication apparatus also has a first memory configured to store at least one predetermined character string, and has a second memory configured to store a predetermined image data fixed code. The image communication apparatus has a controller which searches for character string in a [From:] field of the header of the received e-mail, compares the character string in the [From:] field of the header with the at least one predetermined character string stored in the first memory, searches for an image data fixed code

contained in the image data part of the message of the body of the received e-mail when the character string in the [From:] field of a header matches the at least one predetermined character string stored in the first memory, and judges that the received e-mail is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the second memory. The error mail is related to an e-mail transmitted by the image communication apparatus. Claims 35-36 recite related methods.

Regarding the rejection of claims 13-15 and 20-22 under U.S.C. § 103(a), the Examiner asserts that the recited features of the controller are disclosed in TOYODA et al. However, the cited portions of TOYODA et al. merely disclose judging whether or not an error occurs in a transmission of print data to the facsimile (column 6, lines 38-46) and recognizing identification information of a transmitter and a receiver's electronic mail address which are written in the received facsimile data (column 6, lines 57-61). TOYODA et al. also discloses that when a receiver's e-mail is received as error information for a transmitter's e-mail, the receiver's e-mail is changed to receiver's facsimile data and the receiver's facsimile data is transmitted to the transmitter specified by the identification information of the transmitter (column 7, lines 52-63).

However, TOYODA et al. does not disclose a header of a received e-mail which includes a predetermined character string, the predetermined character string being related to a sender of the error mail. In this regard, the Examiner asserts in the outstanding Official Action mailed on June 24, 2005 (paragraph 16) that "TOYODA suggested exploration of art and/or provided a reason to modify the image apparatus with the predetermined character string being related to a sender of the error mail

(column 6, lines 57-61 and column 7, lines 52-63)". However, column 6, lines 57-61 merely discloses recognizing identification information of a transmitter and a receiver's electronic mail address which are written in the received facsimile data (not in an e-mail). Thus, TOYODA et al. does not suggest a predetermined character string which is included in a header of a received e-mail. Further, column 7, lines 52-63 merely discloses changing the receiver's e-mail to receiver's facsimile data and transmitting the receiver's facsimile data to the transmitter. This portion of the cited document does not contain any disclosure regarding a predetermined character string which is included in a header of a received e-mail.

Therefore, contrary to the Examiner's assertions, Applicant submits that TOYODA et al. does not suggest exploration of art and/or provided a reason to modify the image apparatus with the predetermined character string being related to a sender of the error mail.

Thus, the pending claims are clearly distinguished over TOYODA et al.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 13-15 and 20-22 are not disclosed or even suggested in TOYODA et al. cited by the Examiner.

RFC 2305 merely provides a general explanation for a simple mode of facsimile transmission using Internet mail. Particularly, section 2.2.1 refers to a general explanation of Headers, and sections 5.1, 5.2.1, and 5.2.2 refer to avoiding unsolicited e-mails by verifying the identity of the sender, such as by encryption-based authentication. However, RFC 2305 does not disclose judging whether or not the received e-mail is an error mail, since RFC 2305 relates to a general explanation for a

simple mode of facsimile transmission using Internet mail. Thus, RFC 2305 does not disclose the features of the present invention.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 13-15 and 20-22 are not disclosed in RFC 2305 cited by the Examiner. Thus, pending claims 13-15 and 20-22 are submitted to be patentable over the Examiner's proposed combination, since neither TOYODA et al. nor RFC 2305 (nor any proper combination thereof) discloses the combination of features recited in Applicant's claims. Specially, TOYODA et al. does not provide any suggestions for modifying the image apparatus by the utilization of a predetermined character string that is related to a sender of the error mail, as recited in at least claim 13.

Regarding the rejection of claims 16-19, 23-26, 27, and 32 under 35 U.S.C. § 103(a), the Examiner admitted, in the outstanding Official Action mailed on January 14, 2005 that TOYODA et al. does not disclose a controller which searches for a predetermined image data fixed code in the image data part of the e-mail when the received e-mail is a multi-part structure, and judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected.

However, the Examiner asserts in the outstanding Official Action mailed on June 24, 2005 that TOYODA et al. discloses a controller which searches for a predetermined image data fixed code in the image data part of the e-mail when the received e-mail is a multi-part structure, and judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the

predetermined image data fixed code is detected (column 6, lines 38-46 and lines 57-61, and column 7, lines 52-63).

As noted above, these cited portions of TOYODA et al. disclose judging whether or not an error occurs in a transmission of print data to the facsimile (column 6, lines 38-46) and recognizing identification information of a transmitter and a receiver's electronic mail address which are written in the received facsimile data (column 6, lines 57-61). TOYODA et al. also discloses that when a receiver's e-mail is received as error information for a transmitter's e-mail, the receiver's e-mail is changed to receiver's facsimile data and the receiver's facsimile data is transmitted to the transmitter specified by the identification information of the transmitter (column 7, lines 52-63).

Thus, these cited portions of TOYODA et al. do not contain any disclosure regarding a controller which searches for a predetermined image data fixed code in the image data part of the e-mail when the received e-mail is a multi-part structure. TOYODA et al. also does not contain any disclosure regarding a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 16-19, 23-26, 27, and 32 are not disclosed in TOYODA et al. cited by the Examiner.

PRAITIS et al. relates to a client system in which, when an error is detected, the browser analyzes the response to determine whether the response comprises a friendly



error page, and when the response is not the friendly error page, the browser replaces the page returned in the response with a friendly page.

PRAITIS et al. analyzes a response header 94 contained in a response 90 (Fig. 6, 208 and column 9, lines 36-37). However, the response 90 is a command communicated between the browser module 82 and the networking software module 86 (Fig. 5 and column 7, lines 19-23), but is not an e-mail as required by the pending claims. PRAITIS et al detects whether an error occurred in the server, using a status code number contained in the response header 94 (Fig. 6, 210 and column 9, lines 37-43).

Thus, PRAITIS et al. does not disclose a controller which searches for a predetermined image data fixed code "in the image data part of the e-mail" when the received e-mail is a multi-part structure. Rather, PRAITIS et al. analyzes a status code number in a response header 94 of the response 90 (not an e-mail). PRAITIS et al. does not disclose a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected, since PRAITIS et al. does not search for a predetermined image data fixed code in the image data part of the e-mail.

Further, PRAITIS et al. analyzes a response body 92 of a response 90 to determine whether the response body 92 is a friendly response (Fig. 6, 212 and column 9, lines 52-62). However, this decision is not performed for determining whether an error occurs. Rather, when the response body 92 is not a friendly response, the

browser of PRAITIS et al. displays (i.e., substitutes) a friendly page instead of the body of the response (column 9, lines 63-66).

Thus, PRAITIS et al. does not disclose a controller which searches for a predetermined image data fixed code "in the image data part of the e-mail" when the received e-mail is a multi-part structure. Rather, PRAITIS et al. analyzes a response body 92 of the response 90 (not an e-mail). Thus, PRAITIS et al. does not disclose a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected. Rather, PRAITIS et al. replaces the page returned in response with a friendly page, when the response body is not a friendly response.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 16-19, 23-26, 27, and 32 are not disclosed in PRAITIS et al. cited by the Examiner. The pending claims 16-19, 23-26, 27, and 32 are submitted to be patentable over the Examiner's proposed combination, since neither TOYODA et al. nor PRAITIS et al. (nor any proper combination thereof) disclose the combination of features recited in Applicant's claims.

MORI relates to a network facsimile apparatus which receives electronic mail via a local area network and transmits facsimile data through facsimile communications procedures via PSTN.

MORI also discloses the sub-headers Z1, Z2, and Z3 including the boundary "Content-Type" (Figs. 5 and 7, and column 11, lines 33-35). However, the boundary "Content-Type" is contained in a header of an e-mail, but not in a image data part of the

body of the e-mail. Thus, MORI does not disclose a controller which searches for a predetermined image data fixed code "in the image data part of the body of the e-mail" (claim 16) when the received e-mail is a multi-part structure.

Further, MORI does not disclose judging that the received e-mail is an error mail as evidenced by Fig. 10AA. Rather, MORI detects series of characters to find the sub-headers (Fig. 10AA, S204, and column 13, lines 53-57). MORI determines that contents of a information file is a MINE formatted text (Fig. 10AA, S205 and column 13, lines 63-67). MORI converts the MINE formatted text into original symbol/character codes (Fig. 10AA, S206 and column 14, lines 1-5). Thus, MORI does not contain any disclosure regarding a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 16-19, 23-26, 27, and 32 are not disclosed in MORI cited by the Examiner. The pending claims 16-19, 23-26, 27, and 32 are submitted to be patentable over the Examiner's proposed combination, since none of TOYODA et al., PRAITIS et al., and MORI (nor any proper combination thereof) disclose the combination of features recited in Applicant's claims.

Regarding the Examiner's rejection of the dependent claims 28-29 and 33-34, since these claims are dependent from allowable independent claims 27 and 32, which are allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record.

Accordingly, the Examiner is respectfully requested to withdraw all rejections under 35 U.S.C. § 103(a).

In the rejection of dependent claims 28, 29, 33, and 34, Examiner relied upon, *inter alia*, IWAZAKI. However, IWAZAKI is not available as a reference against the pending claims. Applicant notes that the IWAZAKI reference issued as a patent on February 3, 2004 and was filed in the U.S. Patent and Trademark Office on May 31, 2000. Thus, its availability as a reference against any of the claims in the present application is only under 35 U.S.C. § 102(e). In this regard, Applicant notes that the present application is based on and enjoys the effective filing date of JP 11-321411 which was filed on November 11, 1999, which is before the 35 U.S.C. § 102(e) date of the IWAZAKI reference relied on by the Examiner. Thus, Applicant submits that the IWAZAKI reference is an inappropriate basis for the rejection of any of the claims in the present application.

In view of the fact that IWAZAKI was only applied in the rejection of several dependent claims, and in view of the clear evidentiary showing regarding the patentability of the respective independent claims, Applicant respectfully declines to file a certified translation of the priority document at this time.

Applicant further respectfully traverses the Examiner's position as set forth in the "Response to Arguments". Initially, Applicant did not make arguments regarding the "age" of the references. Rather, the availability of IWAZAKI was traversed based on the effective filing date of the present application.

Further, Applicant, in addition to arguing the shortcoming of the references individually, also asserted various deficiencies of the asserted combinations of references, for, *inter alia*, lacking proper motivation.

Regarding TOYODA et al., Applicant asserted that, the controller, as recited in the various combinations, is not taught by TOYODA et al. A controller, as recited in the pending claims does not “naturally flow” from TOYODA et al. TOYODA et al. does not determine that an e-mail is error mail by determining whether the header includes a predetermined character string related to a sender of the error mail.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding objections and rejections, and an indication of the allowability of all the claims pending in the present application, in due course.

**SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for improved clarity only and has requested reconsideration by the Examiner.

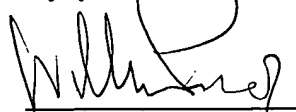
With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the pending claims with the disclosure of the references. Applicant also has pointed out the impropriety of the rejections as well as the inadequacy of the references relied on. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, have not been specifically noted to overcome a rejection based upon the prior art, and should be considered to have been made for a purpose unrelated to patentability. Thus, no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

August 31, 2005  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191

Respectfully submitted,  
Kyoji SAITO

  
\_\_\_\_\_  
Bruce H. Bernstein  
Reg. No. 29,027

William Pieprz  
Reg. No. 33,630